

## REMARKS

Reconsideration is respectfully requested.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

### Paragraph 1 of the Office Action

The election is affirmed.

Claims 1 through 6 and 8 through 13 have been cancelled without prejudice.

Added claims 20 through 24 are directed to features of the earpiece cover and the mouthpiece cover that are shown in Figure 5 of the drawings of the application.

### Paragraphs 2 through 6 of the Office Action

Claims 7 and 14 through 15 have been rejected under 35 U.S.C. §102(b) as being anticipated by Provence (US 5501329).

Claims 16 through 18 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Provence in view of Sherman (US 3856571).

Claim 19 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Provence in view of Lo et al. (US 5054063).

The requirements of claim 14 have been incorporated into claim 7, and therefore claim 7 has been cancelled.

Claim 7, particularly as amended, requires "a case for protectively holding the attachments during periods of non-use of said earpiece and mouthpiece attachments, said case defining an interior for receiving said attachments for storage, said case comprising a compartment portion and a lid portion, each of said portions of said case having a central section and a pair of lobe sections for each receiving one of said attachments, said lobe

sections extending from said central section, said central section being constricted in width as compared to a width of said lobe sections". The claimed case provides protective storage for the individual and different earpiece and mouthpiece attachments of the invention.

The rejection in the Office Action of the claims (requiring the case having the features now set forth in claim 7) relies upon a combination of the Provence and Sherman patents in attempting to assemble the combination of elements required by those claims.

It is significant to note that the courts have recognized that most elements of inventions can be found somewhere in the prior art.

Most if not all inventions arise from a combination of old elements. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998).

In re Kotzab, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000).

And thus the ability to find each one of the claimed elements in the prior art does not in and of itself negate patentability.

Thus, every element of a claimed invention may often be found in the prior art. See *id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

In re Kotzab, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000).

The Office Action sets forth a number of reasons that are alleged to support the combinations of the various parts of the cited references. However, these reasons do not appear to be taken from

the prior art, but from an ex post facto analysis of the combination of the features disclosed in the applicant's application, and possible benefits of the applicant's invention applied to the prior art parts.

In particular, the Office Action states that it would have been obvious "to apply the design of Sherman's carrying case to carry sanitation covers, such as Provence's covers or other design of sanitation covers". However, Provence clearly teaches a pair of substantially identical covers that are intended to be interlocked or nested together when not in use. See, for example, Figure 2 of the Provence patent and the specification of the Provence patent at col. 3, lines 25 through 25:

FIG. 2 is an elevation view of a pair of the telephone handset covers coupled together in a storage position.

Thus, Provence clearly teaches that the covers of the cover means 12 should be coupled together when not use and being stored. Not only does this clearly make the cover means more compact when stored, but it also serves the purpose of encapsulating the possibly contaminated surfaces of the cover means, as set forth in the Provence patent at col. 3, lines 54 through 60:

As shown in FIG. 2, the engaging means 16 further operates to couple a pair of the telephone handset covers 10 together such that contaminated interior portions thereof are substantially encapsulated. By this structure, an individual can effect sanitary covering of the communicating portions of the telephone handset such as can be found with a public telephone or like structure.

Thus, it is important to the function of Provence that the cover portions be nested when not in use for encapsulating any contamination thereon.

Further, Provence clearly provides a compact cylindrical storage case 40 that takes advantage of the compact configuration of

the cover portions in the storage condition illustrated in Figure 2 of Provence.

The storage container of Sherman, in contrast, has separated storage chamber areas and is clearly intended to hold two contact lenses separately from each other, as any contact, coupling or nesting of the contact lenses may damage or destroy the contact lenses. Thus, it is clear that the Sherman structure for the storage container is especially suitable for holding items that cannot be stored in close proximity to each other.

It is therefore submitted that one of ordinary skill in the art, considering the disclosure of the Provence patent, would not be motivated by the Sherman patent to modify the case 40 of Provence to include the separated storage chamber areas of Sherman, as this would not only make the case 40 of Provence more bulky and less compact, but storage of the Provence cover portions separately would not have the encapsulation benefit set forth in Provence.

However, a motivation must be provided by the prior art to make the allegedly obvious combinations of parts relied upon in making an obviousness rejection.

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc. , 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998).

In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Absent a showing of motivation in the prior art to make the allegedly obvious combination, it can only be assumed that the applicant's disclosure has provided the motivation for making the

combination of elements from the prior art, and not the prior art itself.

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. See, e.g., Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

It is therefore submitted that the combination of individual parts taught by the various prior art references relied upon in the Office Action would not motivate one skilled in the art to arrive at the applicant's claimed invention.

Withdrawal of the §102(b) and §103(a) rejection of claims 7 and 15 through 19 is therefore respectfully requested.

VERSION WITH MARKINGS TO SHOW CHANGES MADE:

In the Claims (bracketed parts deleted and underline parts added):

Cancel claims 1 through 6 without prejudice as being directed to a non-elected species of the invention.

7. (Amended) A system for covering a mouthpiece and an earpiece of a telephone for protecting a user from contact with the mouthpiece and earpiece, said system comprising:  
an earpiece cover attachment comprising:

a central wall with front and back surfaces and an outer perimeter, and a perimeter wall extending around said outer perimeter of said central wall, the back surface of said central wall and an inner surface of said perimeter wall defining a space adapted for receiving a portion of the earpiece of a telephone therein;

said central wall having a plurality of holes extending through said front and back surfaces of said central wall;

a mouthpiece cover attachment comprising:

a primary wall with front and back surfaces and an outer perimeter, and a peripheral wall extending around said outer perimeter of said primary wall, the back surface of said primary wall and an inner surface of said peripheral wall defining a space adapted for receiving a portion of the mouthpiece of a telephone therein;

said primary wall having a plurality of holes extending through said front and back surfaces of said primary wall; and

a case for protectively holding the attachments during periods of non-use of said earpiece and mouthpiece attachments, said case defining an interior for receiving said attachments for

storage, said case comprising a compartment portion and a lid portion, each of said portions of said case having a central section and a pair of lobe sections for each receiving one of said attachments, said lobe sections extending from said central section, said central section being constricted in width as compared to a width of said lobe sections.

Cancel claims 8 through 13 without prejudice as being directed to a non-elected species of the invention.

Cancel claim 14.

15. (Amended) The system of claim [14] 7 wherein [said case comprises a compartment portion and a lid portion,] said lid portion being pivotally mounted on said compartment portion such that the lid portion is pivotal between a closed condition in which the interior of said case is inaccessible and an open condition in which the interior of said case is accessible.

16. (Amended) The system of claim [15] 7 wherein [each of said portions of said case has a central section and a pair of lobe sections extending from said central section,] said pair of lobes [extending] extend in substantially the same direction from said central section [, each of said lobes of said portions being adapted to receive one of said attachments].

17. (Amended) The system of claim [15] 7 additionally comprising a locking mechanism for selectively locking said portions in the closed condition.

18. (Pending) The system of claim 17 wherein said locking mechanism comprises a finger tab mounted on said compartment portion, the finger tab being positioned to engage a portion of said

lid portion when said portions are in said closed condition, said finger tab releasing engagement with said lid portion when a finger is pressed on said finger tab.

19. (Amended) The system of claim [17] 7 wherein a marking surface is formed on the front surface of said primary wall of said mouthpiece cover attachment, said marking surface being adapted for being marked on by a writing instrument for permitting writing of telephone calling related information thereon.

Please add the following claims

20. (Added) The system of claim 7 additionally comprising a ridge being formed in said central wall, said ridge protruding from a plane of said central wall for permitting abutment of the ridge against an ear of the user.

21. (Added) The system of claim 20 wherein said ridge is annular and continuous for forming a substantially closed chamber between the front surface of said central wall and the ear of the user to block external noise from entering said chamber.

22. (Added) The system of claim 7 wherein a lip is formed in said primary wall for directing voice sounds of the user toward said plurality of holes, said lip protruding from a plane of said primary wall.

23. (Added) The system of claim 22 wherein said lip is generally semicircular and extends along a semicircular portion of the outer perimeter of said primary wall.

24. (Added) The system of claim 23 wherein said plurality of holes is generally located in a semicircular region of said primary wall defined by said lip.

**CONCLUSION**

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

  
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